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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,800	10/27/2000	Kenneth Snowden	476-1951	5134

7590 06/07/2004

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EXAMINER

HOFFMANN, JOHN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)
09/698,800	SNOWDON ET AL.
Examiner	Art Unit
John Hoffmann	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1.5, 7-9, 35, 36 and 39-45 is/are pending in the application.
- 4a) Of the above claim(s) 39-45 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 and 36 is/are allowed.
- 6) ☒ Claim(s) 1.5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

Newly submitted claims 39-45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The invention of the new claims would require a new search that would place an undue burden on the Office. The new invention can be made by a materially different process, such as one where a frit (rather than a preform) is used – and where another type of heating is required. It is deemed to be in combination/subcombination with the previously presented product claims. The new claims do not require the composition of the

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39-45 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Allowable Subject Matter***

Claims 35-36 are allowed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for " the preform generating sufficient heat..." (lines 5-6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVore 5658364 in view of Yamauchi 5515473.

DeVore discloses the invention as claimed, except for the low melting-point preform. Yamauchi discloses that using high melting point glass causes problems: col. 1, lines 55-61. The melting temperature of the Yamauchi is 430 C (col. 6, line 43) or at least no higher than 440 C (col. 5, line 30). It would have been obvious to use the Yamauchi glass in the DeVore method, so as to prevent the higher temperatures from

influencing the fiber. Alternatively, it would have been obvious to use the use a low melting point glass - because the lower the temperature, the lower the chance of damaging the fiber.

As to the capillary limitation, DeVore does not teach such. However, such would be inherent. Since DeVore does what Applicant does, DeVore would get the same results. Attention is directed to figures 4A-4B of DeVore: glass 32 shows a meniscus that suggests capillary action. It would seem, the glass would have flowed up into the narrow bore at the top of ferrule 40. Although the embodiment of figure 4A-4B are heated by a torch, the reference teaches using induction heating. It is clear that the heating methods, and the cup designs are interchangeable.

It is noted that figure 2 of Kramer 5337387 shows that the particular arrangement of parts results in capillary flow into the small bore of substantially the same type of metal cup.

See col. 3, lines 12-33 of DeVore for the rest of the limitations. As to the various limitations regarding what objects are brought into position relative to other objects: the order of adding ingredients is generally not a patentable distinction. New and unexpected results is the most common secondary consideration to demonstrate an exception to this.

It is noted that it would have been obvious to not damage any of the coating - or else, if the coating is damaged, it would have been obvious to remove it is subsequent applications of the process, so as to prevent it from being ruined.

It is deemed that the strength is "high" and the bonding area is "large" relative to the strength and area prior to the heating and/or prior to the cooling.

Claim 5 is clearly met.

Claim 7 is met for the same reasons claim 1 is. Further, see col. 3, line 4.

Claims 8-9: Figure 6 of Yamauchi indicates that about 490C is the lower limit for the specific conditions that Yamauchi uses. It would have been obvious to use an even lower melting point glass than Yamauchi uses (and thus use a lower processing temperature) so as to further reduce the risk of damage to the fiber. It is noted that if Applicant argues that one would not know how to create a lower melting point sealing glass, such may be used as evidence that one would not be enabled to make and use applicant's invention - beyond the specific compositional teachings. In other words, there may be a question as what scope is presently enabled. Presently, all the claims are deemed to be enabled.

### ***Response to Arguments***

Applicant's arguments have been considered but are not persuasive.

It is argued that DeVores "requires" a layer of insulation. DeVores nowhere requires it. Rather, it is used in one embodiment.

It is further argued that DeVore does not teach controlling the stress in the fiber. The claims do not require controlling the stress, thus it does not matter whether DeVore controls it.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Although the arguments against Yamauchi, may be relevant had the rejection been based on Yamauchi alone, the rejection is based on a combination.

It is argued that Yamauchi teaches heating to 550 C. At best, this argument pertains to claims 8 and 9. However, the rejection of claims 8-9 is based on it being obvious to use a glass of the lowest possible melting point temperature – there is no indication that the rejection of claims 8-9 is based on a specific temperature disclosed in Yamauchi.

The discussion regarding compressive forces and firm positioning were considered, but are not deemed relevant. Such things are relative – and the claims do not specify any specific values for any of these.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

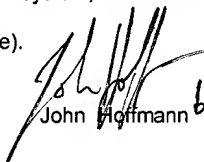
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272-1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John Hoffmann 6-1-04



Primary Examiner  
Art Unit 1731

jmh